



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,647	02/20/2004	George Mulcaire-Jones	50221-00002	7353

25231 7590 12/09/2008  
MARSH, FISCHMANN & BREYFOGLE LLP  
8055 East Tufts Avenue  
Suite 450  
Denver, CO 80237

EXAMINER
----------

HOEKSTRA, JEFFREY GERDEN

ART UNIT	PAPER NUMBER
----------	--------------

3736

MAIL DATE	DELIVERY MODE
-----------	---------------

12/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/783,647

**Applicant(s)**

MULCAIRE-JONES, GEORGE

**Examiner**

JEFFREY G. HOEKSTRA

**Art Unit**

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice of Amendment***

1. In response to the amendment filed on 09/22/2008, amended claim(s) 13, 16-23, and 27 is/are acknowledged. The current rejections of the claim(s) 13-29 and 31 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13-29 and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al. (US 6,747,917 B2, hereinafter Jennings).

4. Jennings discloses a menstrual cycle monitoring apparatus (as best seen in Figures 1-2), comprising:

- a string (100);
- a plurality of beads (102,104,106,108,110,112) comprising at least ten bead types, wherein said plurality of beads are positioned and removed on/from said string (column 6 lines 52-57), wherein said plurality of beads comprising at least ten bead types includes up to 32 different bead type indicators having varying colors, shapes, sizes, and indicia (column 2 line 28 – column 3 line 21, and column 7 line 52-

- column 8 line 9), wherein any of the plurality of beads is capable of being oriented in at least three different orientations (for example forward facing on the string, backward facing on the string, forward facing on the string with band element 114, and backward facing on the string with band element 114), and wherein any of the plurality of beads is capable of being "associated with a fertile phase of the woman's menstrual cycle one of which is associated with the day the woman's menses phase crosses over to a fertile phase of the woman's menstrual cycle, wherein the type of bead associated with the day the woman's menses phase crosses over to the fertile phase of the woman's menstrual cycle is capable of comprising a tri-color bead having three holes formed therethrough, wherein a first one of the holes is capable of including an opening in a first color portion of the tri-color bead, the first color portion is capable of being associated with a continued menstrual bleeding result of the observation, a second one of the holes is capable of including an opening in a second color portion of the tri-color bead, the second color portion is capable of being associated with a dry or absent cervical mucus result of the observation, and a third one of the holes is capable of including an opening in a third color portion of the tri-color bead, the third color portion is capable of being associated with a sticky or egg-white cervical mucus result of the observation"; and
- an ovulation prediction kit (column 1 line 39 – column 2 line 9) capable of providing results indicative of luteinizing hormone levels and associated with any one of the plurality of beads and/or bead types and capable of associating/correlating a surge

luteinizing hormone level with the day of a cervical mucus peak in the woman's menstrual cycle.

5. Jennings discloses "...if the preferred shapes of beads are not locally available, other shapes can be used without departing from the present invention..." (column 8 lines 7).

6. Jennings discloses the claimed invention, as set forth and cited above, except for expressly disclosing the different colors and/or shapes of the plurality of beads. It is well known to one of ordinary skill in the art that beads may be substituted for other beads with regards to their size, shape, and/or color to provide a different visual indicia for monitoring a woman's menstrual cycle.

7. The claimed invention would have been obvious because a person of ordinary skill at the time of the invention would have a good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to try using different colors and/or shapes of a plurality of beads as taught by Jennings in an attempt to provide an alternate bead configuration, as a person with ordinary skill has a good reason to pursue the known options within his or her technical grasp. In turn, because Jennings structural properties predicted by the prior art, it would have been obvious to make an alternate bead arrangement.

***Response to Arguments***

8. Applicant's arguments with respect to claims 13-29 and 31 have been considered but are moot in view of the new ground(s) of rejection, wherein the new grounds of rejection relies upon a new and/or different interpretation of previously applied prior art and/or includes additional limitations not previously and expressly cited in a rejection with the previously applied prior art.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY G. HOEKSTRA whose telephone number is

(571)272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey G Hoekstra/  
Examiner, Art Unit 3736

/Max Hindenburg/  
Supervisory Patent Examiner, Art Unit 3736